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| EXAMINER | |
|---|---|
| BEKKER, KELLY JO | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1794 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/629,991 | STEVENS ET AL. | |
| | Examiner | Art Unit | |
| | KELLY BEKKER | 1794 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 May 2009 and 15 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-23 and 35-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 35-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Amendments made 5/26/09 have been entered.
Claims 1-23 and 35-49 remain pending.

### *Claim Rejections - 35 USC § 112 2nd Paragraph*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claim 16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in light of applicant's amendments made May 26, 2009.

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 7-23, 35-38, 41, and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roskam et al. (US 2003/0044488 A1) in view of Lenchin et al (US 4510166). The references are incorporated herein and as cited in the office action mailed November 25, 2008.

Regarding the newly added limitations, Roskam teaches that the pick up for the coating composition is applied as slurry, and that the slurry composition includes 32-48% solids. Roskam teaches that the coating is dried but can be applied as a slurry. Roskam teaches that the dried coating composition includes 50-100% modified starch, including oxidized substituted starch, 4-20% dextrin (i.e. a film former), 0.1-0.3% stabilizers including xanthan gum, 11% sugar, i.e. granulated sugar, and 0.1-3% leavening agents comprising 0.1-3% sodium acid pyrophosphate and/or 0.1-3% sodium bicarbonate. Refer specifically to paragraphs 0020-0023.

The 103(a) rejection of claim 6 as being unpatentable over Roskam et al. (US 2003/0044488 A1) in view of Lenchin et al (US 4510166) has been withdrawn in light of applicant's amendments filed May 26, 2009.

Claims 6, 39, 40, 42, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roskam in view of Lenchin et al (US 4510166), further in view of Fennema ed. (Food Chemistry 3rd Edition). The references are incorporated herein and as cited in the office action mailed November 25, 2008.

Regarding the newly added limitations, Roskam teaches that the dried coating composition includes 50-100% modified starch, including oxidized and/or acetylated substituted starch (paragraphs 0022). Claim 6 recites limitations similar to those previously recited in claims 39, 40, and 49, and thus is rejected for the same reasons of record claims 39, 40, and 49 were previously rejected.

Claims 1-5, 7-11, 14-20, 22, 23, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazard et al. (EP 0547551 A1) in view of Tsen et al (US 3773521). The references are incorporated herein and as cited in the office action mailed November 25, 2008.

Regarding the newly added limitations, Lazard teaches that the coating composition is applied as a slurry with 5-40% water and thus 60-95% solids (abstract). Lazard teaches that the coating composition contains 5-40% modified starch component (abstract), 0-5% stabilizers, 0-5% acids and bases, i.e. leavening agents, 0-5% flavorants (page 5 lines 11-16), and 20% corn dextrin (table XII). Lazard teaches that the coating composition is allowed to solidify to a solid film, i.e. the films are dried (Page 8 line 56 through page 9 line 12). Thus, based on dry weight or the dried coating composition of Lazar, the composition comprises 12.5-66.7% starch, 26.6-80% corn dextrin, 0-16.7% stabilizers, 0-16.7% leaving acids, and 0-16.7% flavorants.

The 103(a) rejection of claim 6 as being unpatentable over Lazard et al. (EP 0547551 A1) in view of Tsen et al (US 3773521) has been withdrawn in light of applicant's amendments filed May 26, 2009.

Claims 12, 13, 21, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazard et al. (EP 0547551 A1) in view of Tsen et al (US 3773521), further in view of Lenchin et al. (US 4510166). The references are incorporated herein and as cited in the office action mailed November 25, 2008.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazard et al. (EP 0547551 A1) in view of the combination of Tsen et al (US 3773521), further in view Fennema ed. (Food Chemistry 3rd Edition pages 201-204).

Lazard teaches of a composition including pastry products at least partially coated with a moisture barrier as discussed above. Lazard is silent to the oxidized modified wheat starch as substituted to a particular degree and to the wheat starch as including acetylated starch as recited in claim 6.

Fennema teaches that starches are modified to improve their behavioral characteristics (Page 201 Section 4.4.9 Paragraph 1). Fennema teaches that acetylation of starch lowers gelatinization temperature, improves paste clarity, and provides stability to coating compositions (page 202). Fennema teaches that modified starch usually has a substitution level of less than 0.1 and generally within the range of 0.002-0.2 (Page 201 Section 4.4.9 Paragraph 3).

Regarding the substitution level of the starch, since, Lazard teaches of a modified starch but does not teach of the substitution level of the starch, one of ordinary skill in the art would have been motivated to look to the food art, such as Fennema, to find the starch substitution level. One would have been motivated to use starch with a substitution level of 0.002-0.2 as taught by Fennema since it was commonly utilized in foods and would be readily available.

Regarding the starch as acetylated, t would have been obvious to one of ordinary skill in the art at the time the invention was made for the modified starch in the coating composition as taught by Lazard to include acaetylated starch in view of Fennema. One would have been motivated to use acetylated starch in the coating in order to improve paste clarity and provide stabilization as taught by Fennema.

Claims 35-38, 41, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazard et al. (EP 0547551 A1) in view of the combination of Tsen et al (US 3773521) and Baur et al (WO 94/21143). The references are incorporated herein and as cited in the office action mailed November 25, 2008.

Regarding the newly added limitations, Lazard teaches that the coating composition is a slurry with 5-40% water and thus 60-95% solids (abstract). Lazard teaches that the coating composition contains 5-40% modified starch component (abstract), 0-5% stabilizers, 0-5% acids and bases, i.e. leavening agents, 0-5% flavorants (page 5 lines 11-16), and 20% corn dextrin (table XII). Lazard teaches that the coating composition is allowed to solidify to a solid film, i.e. the films are dried (Page 8 line 56 through page 9 line 12). Thus, based on dry weight or the dried coating composition of Lazar, the composition comprises 12.5-66.7% starch, 26.6-80% corn dextrin, 0-16.7% stabilizers, 0-16.7% leaving acids, and 0-16.7% flavorants.

Claims 39, 40, 42, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazard et al. (EP 0547551 A1) in view of the combination of Tsen et al (US 3773521) and Baur et al (WO 94/21143), further in view Fennema ed. (Food Chemistry 3rd Edition pages 201-204). The references are incorporated herein and as cited in the office action mailed November 25, 2008.

Regarding the newly added limitations, Lazard is silent to the wheat starch as including acetylated starch as recited in claims 39, 40, and 49.

Fennema teaches that starches are modified to improve their behavioral characteristics (Page 201 Section 4.4.9 Paragraph 1). Fennema teaches that acetylation of starch lowers gelatinization temperature, improves paste clarity, and provides stability to coating compositions (page 202).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the modified starch in the coating composition as taught by Lazard to include acaetylated starch in view of Fennema. One would have been motivated to use acetylated starch in the coating in order to improve paste clarity and provide stabilization as taught by Fennema.

### *Double Patenting*

The text of those sections of U.S. Code not included in this action can be found in a prior Office action.

The provision rejection of claims 1-23 and 35-49 on the ground of nonstatutory obviousness-type double patenting over claims 1, 5-9, 11, 14, 15, and 17-19 of copending Application No. 10682673 (673) has been withdrawn as the copending application was abandoned.

The provisional rejection of claims 1-23 and 35-49 on the ground of nonstatutory obviousness-type double patenting over claims 1, 2, 6-8, 12-17, 23-28, and 47-53 of copending Application No. 10682672 (672) has been withdrawn as the copending application was abandoned.

### *Response to Arguments*

Applicant's arguments filed May 26, 2009 have been fully considered but they are not persuasive.

Applicant argues in the remarks and declarations filed May 26, 2009 and July 15, 2009, that the inventors conceived and reduced the instantly claimed invention to practice before the priority date of Roskam, thus removing Roskam as prior art. Applicant's affidavit and arguments are not convincing as the affidavit does not establish possession of whole invention as claimed or something falling within the claim, in the sense that the claim as a whole reads on it (MPEP 715.02). For example, the affidavit shows a coating that was reduced to practice with a starch percentage of about 50% and dextrin of about 32%; the affidavit does not include starch coating showing up to 100% starch, or 60% starch, or 20% dextrin or 40% dextrin as instantly claimed. There is no evidence provided to support that the instantly claimed invention was in fact conceived and reduced to practice prior to the prior art date of March 6, 2003. Thus, as stated above, applicant's affidavit and arguments concerning the affidavit are not

convincing as there is no evidence to show conception and reduction to practice of the instantly claimed invention prior to the prior art date of Roskam.

Applicant argues that Lazard does not teach of 49.31-100% starch by dry weight in the coating composition as instantly claimed; Applicant argues the most Lazard teaches is 40% starch. Applicant's argument is not convincing as 40% starch taught by Lazard is by total weight of the coating composition and not by dry weight. As discussed above, Lazard teaches that the coating composition contains 12.5-66.7% starch by dry weight of the coating composition.

Applicant argues that the coating of Lazard is visible as it contains fat and gelatin. Applicant's argument is not convincing as fat is an optional ingredient (abstract) and as Lazard teaches that the coating composition is translucent (Page 9, lines 19-24).

Applicant argues that the coating composition is not dried, applicant's argument is not convincing as Lazard teaches that the coating composition is allowed to solidify to a solid film, i.e. the films are dried (Page 8 line 56 through page 9 line 12). Furthermore, it is noted that the coating composition of the instant invention is also applied as a slurry; i.e. in a non-dried form.

Applicant argues that to choose the claimed viscosity as recited in claims 12, 13, 21, and 47, i.e. the solubility level of the corn dextrin, would not be obvious and to say such would be hindsight reconstruction. Applicant's argument is not convincing. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the obviousness rejection takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure; Lenchin et al. (Lenchin) teaches of converted starches in coating compositions (abstract and Column 8 lines 21

and 26-34); Lenchin teaches that the coating strength and texture are a result of the solids and thus solubility level of the starch (Table II); thus based on the teachings of the prior art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the solubility level of the corn dextrin depending on the coating strength and texture desired as taught by Lenchin; To do so would not impart a patentable distinction to the claims as it was within the routine determination and ordinary ingenuity of one of ordinary skill in the art as taught by Lenchin.

In response to applicant's argument that Bauer teaches away from the instant invention because Bauer teaches of adding what starch to coating compositions and the instant invention would not function with a what starch coating, applicant's argument is not convincing as the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

## ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY BEKKER whose telephone number is (571)272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Art Unit 1794

/Kelly Bekker/
Examiner
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